

**Rejections Based Upon 35 U.S.C. § 102(b)**

Claims 1 and 15 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Jursic *et al.*, *Tetrahedron: Asymmetry*, Vol. 5, No. 9, p. 1712 ("the Jursic reference"). Applicants respectfully request reconsideration of this rejection, as the Jursic reference does not disclose or suggest any claimed invention. Indeed, the Jursic reference differs from the claimed inventions in at least three respects: (1) it does not disclose the claimed "acid resolving agent"; (2) it does not disclose the claimed formation of a salt; and (3) it does not disclose any isolation of such a salt.

With respect to point (1), it appears to be the Examiner's position that the Jursic reference is anticipatory because each of the amide-containing compounds disclosed on page 1712 fall within the scope of the claim term "acid resolving agent" because the respective amide hydrogens can, in theory, be removed. Applicants note, however, that the term "acid resolving agent" does not include any and all compounds from which a hydrogen moiety can be removed. Rather, as is clear from a review of the claims, the term refers to compounds that function as acids with respect to the piperadyl acetamide stereoisomers whose use the claims require. Thus, "acids" according to the claims are not compounds that simply include "removable" hydrogen moieties, but, rather, compounds whose hydrogen moieties can be removed by the recited piperadyl acetamides. Significantly, however, there is no reason to suspect that the piperadyl acetamides recited in the claims are sufficiently basic to remove an amide hydrogen from any of

the compounds disclosed on page 1712 of the Jursic reference. Accordingly, the reference cannot be said to disclose the claimed "acid resolving agent."

With respect to point (2), the Office Action appears to suggest that the hydrogen-bonded complexes said to be disclosed by the Jursic reference constitute "salts" of the type recited in the claims. Applicants, however, are unaware of any definition of the term "salt" that includes hydrogen-bonded complexes. Thus, absent evidence demonstrating that such a definition has been used by those skilled in the art, the rejection for alleged anticipation should be withdrawn. With respect to point (3), the Office Action fails to identify any disclosure in the Jursic reference corresponding to the claimed step of "isolating said salts." Applicants request that such disclosure be identified, or that the rejection be withdrawn. *Verdegaal Bros. V. Union Oil Co*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (anticipation is established only if each and every element set forth in a claim is found in a single prior art reference).

#### **Rejections Based Upon 35 U.S.C. § 103(a)**

Claims 1-8, 10-13, and 15 stand rejected under 35 U.S.C. § 103 (a) as allegedly being obvious in view of the Jursic reference, in view of Berrang, *et al.*, CA 97:38738 ("the Berrang abstract"), Ohashi, *et al.*, CA 104:186157 ("the Ohashi abstract"), or Vanderplas, *et al.*, CA 118:101538 ("the Vanderplas abstract"), and/or additional references. Applicants respectfully request reconsideration of these rejections, as the Examiner has still failed to identify

any motivating force that would have impelled persons skilled in the art to seek a replacement for the amide-containing resolving agents disclosed in the Jursic reference, much less any motivating force that would have impelled such persons to use one of the organic acids disclosed in, for example, the Berrang reference in place of such amide-containing resolving agents. As Applicants noted in prior communications, the Jursic reference stresses the importance of using an *amide-containing* resolving agent, and the Examiner has not come forward with any credible reason why any person of ordinary skill without the hindsight provided by Applicants' disclosure would have been motivated to drastically modify the teaching of the Jursic reference by employing an *acid-containing* resolving agent. Although the Examiner appears to suggest that those of ordinary skill would have been motivated to make this modification in view of a disclosure in U.S. Patent No. 4,410,700 relating to the use of tartaric acid and tartranilic acid for a common application, this disclosure clearly would not have provided the requisite motivation. As is clear from their names, both tartaric acid and tartranilic acid are acids, and it is their respective acid functionality (i.e., their respective -COOH groups) which those of ordinary skill would have found of interest in assessing their potential use. Since none of the compounds disclosed in the Jursic reference include a -COOH group, there is no reason to believe that the disclosure in U.S. Patent No. 4,410,700 relating tartaric acid and tartranilic acid would have motivated their use. In the absence of evidence indicating that the skilled artisan would have


been motivated to modify the Jursic disclosure in the manner proposed by the Examiner, the rejections for alleged obviousness are improper and should be withdrawn.

**Rejection Based on Obviousness-type Double Patenting**

Claims 1-8, 10-13 and 15 are rejected under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 1-9 of U.S. Patent 5,936,091. Upon indication of allowable subject matter, Applicants will consider the necessity of filing a terminal disclaimer.

Applicants believe that the foregoing constitutes a full response to the Office Action of record. Furthermore, it is respectfully submitted that this application is now in condition for allowance. Accordingly, an indication of allowability and an early Notice of Allowance are respectfully requested.

Respectfully submitted,



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